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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,724	07/28/2003	Timothy Effrem	MAS001	3513
7590	08/10/2006		EXAMINER	
THE LAW OFFICES OF ROUZ TABADDOR, ESQ. 1745 PENNSYLVANIA AVE. N.W., SUITE #205 WASHINGTON, DC 20006				TALBOT, MICHAEL
		ART UNIT	PAPER NUMBER	3722

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/627,724	EFFREM, TIMOTHY
	Examiner Michael W. Talbot	Art Unit 3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 May 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 13 and 20-30 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 13 and 20-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 July 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>06/15/06</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 13 and 20-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims a chuck effective capacity of "about 5 mm to above". The claimed range is indeterminable since Applicant's own specification does not clearly enable the claimed limitation. Specifically on page 2 in the section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of 0-6.35 mm and again on page 3 in the same section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of "up to at least 6.35 mm". As a result, it has been determined that the specification does not enable the claimed limitation to extend to an infinite range above 6.35 mm as the claims now permit.

Furthermore during a 15 June 2006 Interview, Applicant provided arguments to the fact that the phrase was intended to be read as "up to or greater than at least 6.35". However, if this is the case, the amendment would be objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. Applicant would be required to cancel the new matter in the reply to this Office Action.

In addition, it has been determined that the chuck effective capacity range of 0-6.35 mm disclosed on page 2, lines 4 through 5, in the section entitled "Summary of the Invention" renders a "lack of criticality" since the range incorporates the possibility of a "0" capacity.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13 and 20-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claims 13 and 20-30, the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims a chuck effective capacity of "about 5 mm to above". The claimed range is indeterminable since Applicant's own specification does not clearly enable the claimed limitation. Specifically on page 2 in the section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of 0-6.35 mm and again on page 3 in the same section entitled "Summary of the Invention", lines 4 through 5, the specification discloses a chuck effective capacity of "up to at least 6.35 mm". As a result, it has been determined that the specification does not enable the claimed limitation to extend to an infinite range above 6.35 mm as the claims now permit.

Furthermore during a 15 June 2006 Interview, Applicant provided arguments to the fact that the phrase was intended to be read as "up to or greater than at least 6.35". However, if this is the case, the amendment would be objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new

matter into the disclosure of the invention. Applicant would be required to cancel the new matter in the reply to this Office Action.

6. Regarding claim 20, the phrase “a diameter in the range of about 25 mm to above” is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

7. Regarding claim 20, the phrase “a diameter in the range of about 25.2 mm to about 25.6 mm” is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

8. Regarding claim 21, the phrase “the length of the first portion is in the range of about 35 mm to about 45 mm” is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

9. Regarding claim 22, the phrase “the length of the first portion is about 40 mm” is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

10. Regarding claim 23, the phrase “the diameter of the first portion is about 26 mm” is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

11. Regarding claim 24, the phrase “the thickness of the shrouded wall is in the range of about 0.7 mm to about 1.2 mm” is considered indefinite, since the resulting claim does not

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clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

12. Regarding claim 25, the phrase "the thickness of the shrouded wall is about 0.7 mm-0.8 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

13. Regarding claim 27, the phrase "the second portion has a length in the range of about 40 mm to about 85 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

14. Regarding claim 28, the phrase "the second portion has a length of about 62 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

15. Regarding claim 29, the phrase "the second portion has a diameter of about 25.4 mm" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b).

Allowable Subject Matter

16. Patentability of claims 13 and 20-30 can not be determined at this time due to the rejection(s) under 35 U.S.C. 112, 1st paragraph and 35 U.S.C. 112, 2nd paragraph set forth in this Office action.

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Conclusion

17. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.


MWT
Examiner
31 July 2006


MONICA CARTER
SUPERVISORY PATENT EXAMINER